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Ryoji Hattori

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EXAMINER

DICUS, TAMRA

ART UNIT

PAPER NUMBER

1794

MAIL DATE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/529,716	<b>Applicant(s)</b> HATTORI, RYOJI	
	<b>Examiner</b> TAMRA L. DICUS	<b>Art Unit</b> 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 14-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____.                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>06/22/05, 03/30/05</u> .                                      | 6) <input type="checkbox"/> Other: ____.                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-13, drawn to a recognition-identification card.

Group II, claim(s) 14-18, drawn to a method of manufacturing a recognition-identification card.

2. The inventions listed as Groups I & II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The special technical feature does not provide a contribution over the prior art because the special technical feature (structure and materials of claims 1, 3, and 9) is disclosed in USPN 5,672,563 to Takiguchi et al. and USPN 6,638,635 to Hattori et al.

3. During a telephone conversation with Marshall Chick on Nov. 5, 2007 a provisional election was made with traverse to prosecute the invention of I, claims 1-13. Affirmation of this election must be made by applicant in replying

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to this Office action. Claims 14-18 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

4. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.**

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Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claim 7 recites “a thickness of cushioning layer”, which is confusing as it is not clear if there is another cushioning layer in addition to the cushioning layer of claim 2.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-2 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over USPN 5,672,563 to Takiguchi et al.

11. Takiguchi teaches a thermal transfer image-receiving sheet (recognition-identification card is to intended use) comprising in this order: a dye-receiving layer (an image carrier), UV absorber layer (UV absorber-containing layer, 5:1-5), cushion layer (6:65-7:15), and laminate of white opaque film of white pigment added to PET or polyolefin sheets (first sheet member of white polyester and second sheet member, 5:5-25).

12. To claim 8, Takiguchi does not expressly disclose the printing processes as recited. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Patentability of an

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article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a product NOT a process. *In re Bridgeford*, 357 F. 2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be established. *In re Brown*, 459 F. 2d 531. Both Applicant's and prior art reference's product are the same.

13. While the degree of whiteness value is not disclosed, Takiguchi teaches the same material is used and thus is expected to be an inherent property (Takiguchi teaches white pigments added to the film and white opaque films for the first and second substrate sheets (5:15-20)). It is noted that where the examiner has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, he or she possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on, *In re Swinehart*, 169 USPQ 226, 229 (CCPA 1971).

14. In the alternative, it would have been obvious to one having ordinary skill in the art to have obtained said value since applicant's specification evidences the instant film is commercially available (see instant pg. 85, under Creating the first sheet member using U2L98W, Teijin Dupont Inc. white support member) and thus known in the art. Claims 1-2 and 8 are met.

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15. Claims 1-2, 7-8, and 11-13 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP 2002-222403 to Hattori et al.

16. It is noted that when utilizing JP 2002-222403 in the above paragraph, the disclosures of the reference are based on US PG Pub 20020168513 which is an English language equivalent of the reference. Therefore, the column and line numbers cited with respect to JP 2002-222403 are found in US PG Pub 20020168513.

17. Hattori teaches a personal IC data certification card (recognition-identification card) comprising in this order: an image-receiving layer (an image carrier), cushion layer, polyester film with white pigment (first sheet member), and second sheet member (laminated to first sheet), see [0074-0081]. The cushion layer is on both sides of a support ([0084]), where a photo-polymerizing compound (photocurable resin) and UV absorbent included in a cushion layer (see [0201-0202]), thus having a structure where the UV absorber layer and cushion layer are between the image carrier and sheets as per claims 1-2. The cushioning layer has the TMA recitation of claim 7 is also taught (see [0083]). The image receiving carrier sheet has images certifying identification such as face image and birth date information (see [0070 and 0077], claims 11-13).

18. While the degree of whiteness value is not disclosed, Hattori teaches the same material is used and thus the property is expected to be inherent (Hattori



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teaches white pigments added to the film and white opaque films for the first and second substrate sheets ([0075]).

19. In the alternative, it would have been obvious to one having ordinary skill in the art to have obtained said value since applicant's specification evidences the instant film is commercially available (see instant pg. 85, under Creating the first sheet member using U2L98W, Teijin Dupont Inc. white support member) and thus known in the art. Claims 1-2, 7, 11-13 are met.

20. To claim 8, Hattori does not expressly disclose the printing processes as recited. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a product NOT a process. *In re Bridgeford*, 357 F. 2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be established. *In re Brown*, 459 F. 2d 531. Both Applicant's and prior art reference's product are the same.

21. Claim 9 is rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over USPN 5,672,563 to Takiguchi et al. in view of US 6395459 B1 to Taylor et al.

22. The features of Takiguchi are relied upon above.

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23. To claim 9, the primary reference does not teach a photo-curing and UV absorber top layer.

24. Taylor teaches a transparent curable top overcoat layer of a photopolymerizable composition including a UV absorber for protecting image recording media from fingerprints, stains and spills resulting in a cured water and stain resistant coating (see Abstract, 8:60-9:25).

25. It would have been obvious to one having ordinary skill in the art to have modified the primary reference to include a surface protective top coating of photocurable resin and ultraviolet absorber because Taylor teaches a resultant cured water and stain resistant coating for images as cited above.

26. Claims 4-5 are rejected under 35 U.S.C. 103(a) as obvious over USPN 5,672,563 to Takiguchi et al. in view of USPN 5,852,289 to Masahiko.

27. The Takiguchi reference is relied upon above.

28. Takiguchi does not teach inclusion of an electronic part as claimed (claims 4-5).

29. Masahiko teaches in Fig. 12a, films 203a and 203b at upper and lower sides are formed of polyethylene terephthalate (PET) including an electric part such as a microcomputer or a capacitor for detecting the received electric wave to obtain electric power and data and for transmitting data, in a non-contact card (embraces ID card). See 9:15-35.

30. It would have been obvious to one having ordinary skill in the art to have modified Takiguchi to include an electronic part as claimed because Masahiko teaches including it between PET films for detecting the received electric wave to obtain electric power and data and for transmitting data, in a non-contact card as cited above.

31. Claims 4-5 are rejected under 35 U.S.C. 103(a) as obvious over JP 2002-222403 to Hattori et al. in view of USPN 5,852,289 to Masahiko.

32. The Hattori reference is relied upon above.

33. Hattori does not teach inclusion of an electronic part as claimed (claims 4-5).

34. Masahiko teaches in Fig. 12a, films 203a and 203b at upper and lower sides are formed of polyethylene terephthalate (PET) including an electric part such as a microcomputer or a capacitor for detecting the received electric wave to obtain electric power and data and for transmitting data, in a non-contact card (embraces ID card). See 9:15-35.

35. It would have been obvious to one having ordinary skill in the art to have modified Hattori to include an electronic part as claimed in order to expand the utility of the Hattori et al. card especially since Masahiko teaches including such between PET films for detecting the received electric wave to obtain electric power and data and for transmitting data, in a non-contact card as cited above.

36. Claim 10 is rejected under 35 U.S.C. 103(a) as obvious over USPN 5,672,563 to Takiguchi et al. in view of US 6395459 B1 to Taylor et al. and further in view of USPN 5,852,289 to Masahiko.

37. The combination is relied upon above.

38. The combination does not teach inclusion of an electronic part as claimed (claim 10).

39. Masahiko teaches in Fig. 12a, films 203a and 203b at upper and lower sides are formed of polyethylene terephthalate (PET) including an electric part such as a microcomputer or a capacitor for detecting the received electric wave to obtain electric power and data and for transmitting data, in a non-contact card (embraces ID card). See 9:15-35.

40. It would have been obvious to one having ordinary skill in the art to have modified the combination to include an electronic part as claimed in order to expand the utility of the Takiguchi et al card, especially since Mashiko teaches including such between PET films for detecting the received electric wave to obtain electric power and data and for transmitting data, in a non-contact card as cited above.

41. Claims 11-13 are rejected under 35 U.S.C. 103(a) as obvious over USPN 5,672,563 to Takiguchi et al. in view of USPN 4097279 A to Whitehead.

42. The Takiguchi reference is relied upon above.

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43. Takiguchi does not teach the text and graphics set forth in claims 11-13. First the examiner considers both text and graphics to be equivalent since both are merely patterned markings. Despite this, Whitehead teaches face portraits, with several types of indicia including birthdates on films forming an identification card (see FIGs. 1-2, and 4 and associated text, 11:25-68, 12:1-45).

44. It would have been obvious to one having ordinary skill in the art to have modified Takiguchi to include images and text as claimed since such are typical content for ID cards and because Whitehead teaches they are included for identification purposes on an ID card as cited above.

45. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,908,658 to Nitta et al. in view of US 5,846,900 to Reiter et al.

46. Nitta discloses an electrophotography recording as an identification card (recognition-identification card) having the following layers as shown in FIG. 3 in this order: recording layer 3 (image carrier), polyolefin base film 2 having silane coupling agent (silane coupling agent containing layer), recording layer 3 of polyester (first sheet), and coating urethane layer 4 (second sheet). See 4:35-45.

47. Nitta's polyester first sheet does not recite a whiteness degree or a cushioning layer (claim 3).

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48. Reiter teaches an identification card with a polyester core (and laminate of other polymers thus meeting a second sheet also, 3:5-10, 3:50-55) where white pigment is added to the core for opacification (3:25-55) and a cushion layer between the image receiving layer and polyester film to reduce dropouts in the printing process caused by dirt and dust (4:60-65).

49. It would have been obvious to one having ordinary skill in the art to have modified Nitta to use a white polyester first sheet as taught by Reiter for opacification and to use a cushion layer to reduce dropouts in the printing process caused by dirt and dust as cited above.

50. While the degree of whiteness value is not disclosed in the combination, Reiter teaches the same material, a thickness of 127 to 787 micrometers, and an amount of pigment up to 50% by weight is used and thus the claimed whiteness is expected to be an inherent property.

51. In the alternative, it would have been obvious to one having ordinary skill in the art to have obtained said value since applicant's specification evidences the instant film is commercially available (see instant pg. 85, under Creating the first sheet member using U2L98W, Teijin Dupont Inc. white support member) and thus known in the art.

52. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,908,658 to Nitta et al. in view of US 5,846,900 to Reiter et al. and further in view of USPN 5,852,289 to Masahiko.

53. The combination is relied upon above.

54. The combination does not teach an electronic parts-containing layer (claim 6).

55. However Reiter suggests the ID card may be prepunched for attaching a memory chip (3:5-10).

56. Masahiko teaches in Fig. 12a, films 203a and 203b at upper and lower sides are formed of polyethylene terephthalate (PET) including an electric part such as a microcomputer or a capacitor for detecting the received electric wave to obtain electric power and data and for transmitting data, in a non-contact card (embraces ID card). See 9:15-35.

57. It would have been obvious to one having ordinary skill in the art to have modified the combination to include an electronic part as claimed, since modern ID cards incorporate these features for expanded usefulness and security and because Mashiko teaches including such between PET films for detecting the received electric wave to obtain electric power and data and for transmitting data, in a non-contact card as cited above.

### ***Conclusion***

58. Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAMRA L. DICUS whose telephone number is (571)272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Tamra L. Dicus /TLD/  
Examiner  
Art Unit 1794

March 16, 2008

/Terrel Morris/  
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